UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *11 September 2008*.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *22-40* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) *26, 28, 34 and 36* is/are allowed.
6) ☒ Claim(s) *22-25, 27, 29-33, 35, 37-40* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☒ All   b) ☐ Some *   c) ☐ None of:
        1. ☐ Certified copies of the priority documents have been received.
        2. ☐ Certified copies of the priority documents have been received in Application No. _____.
        3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 22-24, 29-32, 37-40 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Yablon (WO 99/45687) in view of ITU-T Recommendation H.245,

sections 5.2-5.9; (XP-002199601), hereafter, The ITU-T Recommendation.

Regarding the features of claim 22, Yablon teaches a method of identifying a

telecommunications subscriber (see page 23, lines 10-12 and fig. 16, engaging in a

handshake to establish connection with subscriber unit), the method comprising:

setting up device information in a first telecommunication device to indicate at least one

type of subscriber data that the first telecommunication device is accepting (see page

23 lines 13-18 and Fig. 16, establishing the type of data the user device is capable of

receiving, therefore setting up to define type of subscriber data the first device is

accepting); signaling a call from a second telecommunications device (calling device) of

a second telecommunications subscriber to a first telecommunications device of a first

telecommunications subscriber (recipient device) (see fig. 16; page 23, lines 10-12).

(Fig.16 shows a "Handshake", procedure for establishing a call between a first and a

second telecommunication devices. see particularly step 1: Handshake); sending the

device information from the first telecommunications device to the second

telecommunications device (see page 23 lines 13-18 and Fig. 16, the primary user

device sending the calling device information indicating device capability); and

transmitting subscriber data from the second telecommunications device to the first

telecommunications device in accordance with the device information (see fig. 16; page

23, lines 10-23). (Fig.16, steps 1 and 2 shows that subscriber data/information, device's

capability is determined in the 1st step and based on the determination, information is

transmitted in the 2nd step). Furthermore, the first and second devices exchange each

other's device information bi-directionally (see fig. 16, 1st and 2nd steps).

Yablon discloses setting up device information in a first telecommunication

device to indicate at least one type of subscriber data that the first telecommunication

device is accepting, but fails to disclose setting up device information in a first

telecommunication device to define at least one type of subscriber data that the first

telecommunication device is accepting. ITU-T Recommendation teaches setting up

device information in a receiving device to define at least one type of subscriber data

that the receiving device is accepting (see page 3, section 5.2).

Therefore, it would have been obvious to a person having ordinary skill in the art

at the time the invention was made to modify the invention of Yablon, to clearly define

the terminal's ability to receive the type of data, as taught by ITU-T Recommendation,

thus allowing an efficient way of sending data that can be treated appropriately by the

receive terminal (ITU-T Recommendation, page 2 section 5.2).

Regarding the features of claim 30, Yablon teaches a method of identifying a

telecommunications subscriber (see page 23, lines 10-12 and fig. 16, engaging in a

handshake to establish connection with subscriber unit), the method comprising:

setting up device information in a first telecommunication device to indicate at least one

type of subscriber data that the first telecommunication device is accepting (see page

23 lines 13-18 and Fig. 16, establishing the type of data the user device is capable of

receiving, therefore setting up to define type of subscriber data the first device is

accepting); signaling a call from a second telecommunications device of a second

telecommunications subscriber to a first telecommunications device of a first

telecommunications subscriber (see fig. 16; page 23, lines 10-23); sending the device

information from the first telecommunications device to the second telecommunications

device (see page 23 lines 13-18 and Fig. 16, the primary user device sending the calling

device information indicating device capability); transmitting subscriber data from the

first telecommunications device (recipient device) to the second telecommunications

device (calling device) in accordance with the device information (see fig. 16; page 23,

lines 10-18). It is shown in (fig. 16, steps 1 and 2) that a calling device and the recipient

device exchange information on their respective capabilities (step 1) so as to enable

actual transmission of information (subscriber data) (see second step) according to

agreed upon protocol. Furthermore, devices' information (capability) is exchanged bi-

directionally.

Yablon discloses setting up device information in a first telecommunication

device to indicate at least one type of subscriber data that the first telecommunication

device is accepting, but fails to disclose setting up device information in a first

telecommunication device to define at least one type of subscriber data that the first

telecommunication device is accepting. ITU-T Recommendation teaches setting up

device information in a receiving device to define at least one type of subscriber data

that the receiving device is accepting (see page 3, section 5.2).

Therefore, it would have been obvious to a person having ordinary skill in the art

at the time the invention was made to modify the invention of Yablon, to clearly define

the terminal's ability to receive the type of data, as taught by ITU-T Recommendation,

thus allowing an efficient way of sending data that can be treated appropriately by the

receive terminal (ITU-T Recommendation, page 2 section 5.2).

Regarding the features of claim 38, Yablon teaches a method of identifying a

telecommunications subscriber (see page 23, lines 10-12 and fig. 16, engaging in a

handshake to establish connection with subscriber unit), the method comprising:

a memory for storing subscriber data (see fig. 16; page 23, lines 5-9);

a facility for receiving device information of a further telecommunications device which

indicates components of subscriber data that the further telecommunications device is

setup to receive(see fig. 16, steps 1 and 2; page 10-23), wherein the further

telecommunication device is configurable and said device information is indicated

according to a configuration of said further telecommunication device (see fig. 16 and

page 23); a facility for transmitting particular subscriber data from the memory to the

further telecommunications device depending on the device information received (see

fig. 16, steps 1 and 2; page 23, lines 10-23). Fig. 16 includes the facility; and the

particular subscriber data (e.g. video) is determined based on handshake information

exchanged between the two devices.

Yablon discloses device information is indicated by the receiving terminal, but fails to disclose device information is defined to the receiving terminal. ITU-T Recommendation teaches receiving terminal defines the type of data it is capable of receiving (see page 3, section 5.2).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the invention of Yablon, to clearly define the terminal's ability to receive the type of data, as taught by ITU-T Recommendation, thus allowing an efficient way of sending data that can be treated appropriately by the receive terminal (ITU-T Recommendation, page 2 section 5.2).

Regarding claim 40, Yablon teaches a method of identifying a telecommunications subscriber (see page 23, lines 10-12 and fig. 16, engaging in a handshake to establish connection with subscriber unit), the method comprising: a memory for storing device information which indicates a type of subscriber data that a further telecommunications device wants to receive (see fig. 16; page 23, lines 5-9) (see fig. 16, steps 1 and 2; page 10-23), wherein the further telecommunication device is configurable and said device information is indicated according to a configuration of said further telecommunication device (see fig. 16 and page 23); a facility for transferring the device information from the memory to the further telecommunications device (see fig. 16; page 23, lines 5-9). Fig. 16 includes the facility/system; a facility for receiving subscriber data from the further telecommunications device depending on the device information transmitted (see fig. 16, the first and second steps; page 23, lines 10-23). Fig. 16 includes the

facility/system; and transfer of information (subscriber data) is based on the handshake result between the calling and called parties. Furthermore, since, the system is bi-directional, data would have been transmitted from either device and received by the other.

Yablon discloses device information is indicated by the receiving terminal, but fails to disclose device information is defined to the receiving terminal. ITU-T Recommendation teaches receiving terminal defines the type of data it is capable of receiving (see page 3, section 5.2).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the invention of Yablon, to clearly define the terminal's ability to receive the type of data, as taught by ITU-T Recommendation, thus allowing an efficient way of sending data that can be treated appropriately by the receive terminal (ITU-T Recommendation, page 2 section 5.2).

As per claim 23: Yablon teaches a method, wherein at least one of the of the first and second telecommunications devices stores transmission information which indicates which subscriber data has been transmitted from the other respective telecommunications device (see page 23, lines 18-23; page 29, lines 9-20). The prior art identifies caller, electronic mail, text information, etc., which are transmission information.

As per claim 31: the feature of claim 31 is similar to the feature of claim 23. Hence, claim 31 is rejected on the same ground and motivation as claim 23.

As per claim 24: Yablon teaches a method, wherein the transmission information is

transmitted from one telecommunications device to the other telecommunications

device (see fig. 16; page 23, lines 10-15) with the subscriber data (see page 29, lines 9-

20).

As per claim 32: the feature of claim 32 is similar to the feature of claim 24.

Hence, claim 32 is rejected on the same ground and motivation as claim 24.

As per claim 29: the ITU-T Recommendation teaches a method, wherein at least

one of the first and second telecommunications devices stores release information

which indicates which subscriber data should be transmitted to the respective other

telecommunications device (see page 1, paragraphs 1-3). Storing "release information"

is obvious from the fact that information, which indicates, which subscriber data should

be transmitted to the respective other telecommunications device is exchanged.

As per claim 37: the feature of claim 37 is similar to the feature of claim 29. Hence,

claim 37 is rejected on the same ground and motivation as claim 29.

As per claim 39: the feature of claim 39 is similar to the feature of claim 23, with

the exception of the feature, "a further memory" (additional memory), which is provided

by Yablon (see page 23, lines 5-9). Hence, claim 39 is rejected on the same ground and

motivation as claim 23.

3.   Claims 25, 27 and 33, 35 are rejected under 35 U.S.C. 103(a) as being

unpatentable over the references applied to claims 22 and 30 above, and further in view

of Takahashi (US 5,592,546).

As per claim 25, Yablon teaches a method of identifying a telecommunications

subscriber (see page 23, lines 10-12 and fig. 16, engaging in a handshake to establish

connection with subscriber unit), but fails to teach a method wherein the transmission information is assigned historical data, which references the transmitted subscriber data, as claimed by applicant.

However, in a related field of endeavor (telecommunications device), Takahashi teaches about a telephone number retrieval function by using historical information, wherein the technique/method includes a memory for registering remote terminal name and telephone number pairs, in the order of time the respective pairs have been registered, together with respective identification numbers relevant to the respective pairs (the identification numbers being assigned to the respective information pairs according to historical sequence in which the pairs are registered therein), including sort table for storing therein the above identification numbers in the alphabetical order with respective registered names; a transmission/reception history area for storing therein information including the remote terminal telephone numbers used for transmission/reception operations using memory dialing method and usage order table for storing information concerning the frequencies with which the respective pairs have been used in the transmission/reception (see fig. 2, particularly box 7; abstract; col. 3, lines 16-44; col. 10, lines 14-28).

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to further modify the above references for the advantage of improving memory- dialing efficiency (see col. 3, lines 14-15), a feature which telephone devices are known to have.

As per claim 33: the feature of claim 33 is similar to the feature of claim 25.

Hence, claim 33 is rejected on the same ground and motivation as claim 23.

As per claim 27: Takahashi teaches a method, wherein the subscriber data to be

transmitted is referenced to current historical data (see col. abstract; col. 3, lines 20-44).

As per claim 35: the feature of claim 35 is similar to the feature of claim 27.

Hence, claim 35 is rejected on the same ground and motivation as claim 27.

Allowable Subject Matter

4.   Claims 26, 28, 34 and 36 are allowable.

Conclusion

5.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Kaplan et al. (US 2004/0203941) discloses a system and method for mobile

configuration.

6.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to KATHY WANG-HURST whose telephone number is

(571) 270-5371. The examiner can normally be reached on Monday-Thursday, 7:30am-

5pm, alternate Fridays, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Nick Corsaro can be reached on (571) 272-7876. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KATHY WANG-HURST/
Examiner, Art Unit 2617

/NICK CORSARO/

Supervisory Patent Examiner, Art Unit 2617